

REMARKS

The pending Office Action addresses claim 1, 3, and 5-19. Claims 1, 6, and 8-10 are rejected, claims 3, 5, and 7 are objected to, and claims 11-19 are allowed.

Rejection Pursuant to 35 U.S.C. §103

Claims 1, 6, and 8-10 are rejected pursuant to 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 4,667,664 of Taylor in view of U.S. Publication No. 2003/0065391 of Re et al. The Examiner argues that Taylor teaches the claimed invention except for the elongate stem portion having an enlarged head. The Examiner relies on Re to teach this feature, arguing that it would have been obvious to modify the device of Taylor in view of Re to arrive at the claimed invention as the combination would result in a device that would be able to be used in an easier manner. Applicant respectfully disagrees.

The Examiner has failed to provide the required motivation for making the modification described above to the device disclosed in Taylor. The strongest rationale for combining references is a recognition that some advantage of expected beneficial result would be produced by the combination. (See MPEP 2144). There is no advantage to adding to the Taylor device an enlarged head as taught in Re because it would serve no purpose and would in fact interfere with the intended use of the device. The device of Taylor is used for orthopedic surgery and it includes an intramedullary nail 18, which the Examiner argues is the "rod member" of the claimed invention. The Examiner argues that Taylor lacks any such feature. More importantly, the lack of this feature makes perfect sense since the addition of an enlarged head on the end of the intramedullary nail would only hinder implantation of the nail within the femur. As explained in Column 5, lines 11-17, of Taylor, the intramedullary canal of the femur is reamed about 1 millimeter larger than the diameter of the nail that is introduced therein. An enlarged head would prevent the nail from fitting within the reamed area of the canal. Even if the size of the space in the canal was increased to accommodate an enlarged head on the nail, the remaining portion of the nail would not fit properly within the canal. The suggested modification is therefore not obvious.

Moreover, combining Taylor and Re would not yield predictable results. Applicant refers the Examiner to the “Examination Guidelines for Determining Obviousness Under 35 U.S.C 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*” (hereinafter “the Guidelines”). As explained in Section A(2) of the Guidelines, to reject a claim on the basis that combining prior art elements according to known methods yields predictable results, the Examiner must articulate

...a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely would have performed the same function as it did separately

Combining Taylor and Re does not yield a combination where each element performs the same function as it did separately. As noted above, the intramedullary nail would not function in the same way when combined with an enlarged head as taught in Re. Specifically, the nail resulting from the combination of Taylor and Re would no longer be able to be implanted properly due to the enlarged head at an end of the nail. Even if Taylor were further modified to accommodate such a redesigned intramedullary nail, the proximal portion of the nail (i.e., the part without the enlarged head) would not fit properly within the femur. Thus, the combination of the references does not yield predictable results as enumerated in the Guidelines.

Accordingly, claim 1, as well as claims 6 and 8-10 which depend therefrom, distinguish over the combined references and represent allowable subject matter.

Conclusion

In view of the above, Applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

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